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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

H30
B. Webb
2/24/04

Applicants : Michael R. Rosen, et al.

U.S. Serial No.: 09/505,458

Examiner: F. Oropeza

Filed : February 11, 2000 Group Art Unit: 3762

For : CARDIAC REMODELING

1185 Avenue of the Americas
New York, New York 10036
February 13, 2004

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Sir:

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SUPPLEMENTAL COMMUNICATION IN RESPONSE TO
SEPTEMBER 17, 2003 OFFICE ACTION

In the Communication In Response to September 17, 2003 Office Action filed on December 17, 2003, applicants stated that the Ben-Haim et al. device "would not necessarily induce ion channel remodeling or remodel gap junctions", "would not necessarily result in inducing ion channel remodeling or remodeling of gap junctions", and "would not necessarily alter the relative refractory period."

In the Advisory Action dated January 9, 2004, the Examiner stated that:

"These comments appear to acknowledge the impact of the Ben-Haim et al. invention is unknown and appear to acknowledge

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Ben-Haim et al., who applies non-excitatory electrical field that modifies the plateau currents and the force of contraction of the heart (applies an electrical stimulus to the heart that does excite it, resulting in altered activation), also does, at least in certain situations, remodel the gap junctions, alter the effective refractory periods, and induce ion channel remodeling with the electrical field, hence the rejection of record stands".

Applicant's comments were made in response to the Examiner's rejection of the claims based on anticipation in view of the Ben-Haim reference. In order to constitute an anticipation, a reference must disclose all elements of a claimed invention, either explicitly or inherently. To show that a device inherently discloses all elements of a claimed invention, it must be shown that the device necessarily, in all cases, and not merely by accident, mistake or chance, results in the invention claimed. To constitute an anticipation, it is not enough to show that in some cases, but not all cases, the reference results in the claimed invention.

When applicant made the statements (cited above by the Examiner), applicant was demonstrating that a case for anticipation has not been shown, because the Ben-Haim reference does not teach the claimed invention either explicitly or inherently. Applicant's statement was not, and should not, be construed as any acknowledgement that Ben-Haim's device would under any certain situations (nonetheless all situations required to demonstrate inherency) remodel gap junctions, alter the effective refractory periods, and induce ion channel remodeling.

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Accordingly applicant requests reconsideration and withdrawal of the anticipation rejections based on the Ben-Haim reference.

If a telephone interview would be of assistance in advancing prosecution of the subject application, the undersigned attorney invites the Examiner to telephone him at the telephone number provided below.

No fee, other than the \$210.00 for a two-month extension of time and the RCE fee of \$385.00 (totaling \$595.00), is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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